

DECISION OF THE UNITED STATES COURT OF
APPEALS FOR THE FIRST CIRCUIT

UNITED STATES COURT OF APPEALS
For the First Circuit

No. 82-1212 - Dated December 14, 1982

LEATHERSMITH OF LONDON, LTD.,
A NEW YORK CORPORATION,

Plaintiff, Appellant,

v.

PHILIP J.S. ALLEYN, ETC.,

Defendant, Appellee.

APPEAL FROM THE UNITED STATES DISTRICT
COURT FOR THE DISTRICT OF MASSACHUSETTS

[Hon. David S. Nelson, U.S. District
Judge]

Before Davis*, Campbell and Bownes,
Circuit Judges.

Cameron K. Wehringer, with whom William
M. Braucher was on brief, for appellant
Jeffrey F. Jones, with whom Palmer & Dodge
was on brief, for appellee.

* Of the Federal Circuit, sitting by des-
ignation.

DAVIS, Circuit Judge. Plaintiff-appellant Leathersmith of London, Ltd., is the licensee and subsidiary of a British corporation whose leather products it markets in this country (including Massachusetts) under the trademark "Leathersmith" which is registered under the Lanham Act, 15 U.S.C. §§ 1114, 1121, for infringement of the trademark by defendant Philip J.S. Alleyn who had been doing business in Cambridge, Massachusetts as "TANTALUS Custom Leather-smiths & Bookbinders." On cross-motions for summary judgment, the District Court gave judgment for defendant-appellee, holding that "leathersmith" is a generic term for a leather craftsman and therefore not properly registrable as a trademark. We affirm, on somewhat

narrower grounds also urged by appellee.

Alleyn is a skilled leather craftsman and book binder. From 1975 until very recently he operated a small shop in Cambridge under the name given above; from 1971 to 1975 he operated out of his home in Boston under the name "TANTALUS Custom Leathersmiths." He has earned approximately \$8,000 per year from his business. He has taught his craft, and done custom business only--his products are made to order. He sells only his own products and has worked only at his shop (or, previously, at his home). He does no newspaper advertising (or any significant advertising) or general mailing. On some items he makes he has used "TANTALUS" alone. He does not use "Leathersmith" or "Leathersmiths" alone

but always as part of the full name of his business, "TANTALUS Custom Leather-smiths and Bookbinders." Until this dispute arose in 1979, he did not know of plaintiff's trademark or business.

We need not decide whether "Leather-smith" is wholly non-registrable because generic; plaintiff cannot prevail against this defendant even if that term were considered a good and enforceable trademark in other circumstances. The grounds of our more limited holding are, first, that there has been no showing of a likelihood of confusion in this instance, and, second, that defendant's use of "Leathersmiths" in the name of his business is a "fair use" exempted by the Lanham Act from liability.¹

1. All footnotes are at end of Decision.

The Lanham Act, under which this suit lies, gives a remedy for infringement of a registered mark only if the allegedly infringing use "is likely to cause confusion, or to cause mistake, or to deceive." 15 U.S.C. § 1114(1). This element of confusion, mistake or deception is a prerequisite, in this circuit and elsewhere, for relief under that provision. Purolator, Inc. v. EFRA Distributors, Inc., 687 F.2d 554, 559 (1st Cir. 1982); Pignons S.A. v. Polaroid Corp., 657 F.2d 482, 486-87 (1st Cir. 1981); DeCosta v. Columbia Broadcasting System, Inc., 520 F.2d 499, 513 (1st Cir. 1975); Baker v. Simmons Co., 307 F.2d 458, 461 (1st Cir. 1962); Esquire, Inc. v. Esquire Slippers

Manufacturing Co., 243 F.2d 540, 542 (1st Cir. 1957); Venetianaire Corp. of America v. A&P Import Co., 429 F.2d 1079, 1081 (2d Cir. 1970); B&L Sales Associates v. H. Daroff & Sons, 421 F.2d 352, 353-54 (2d Cir. 1970); Amstar Corp. v. Domino's Pizza, Inc., 615 F.2d 252, 258-59, 265 (5th Cir. 1980). The plaintiff has the burden of showing this component--which is not a defense but an essential element of the claim of infringement. See President and Trustees of Colby College v. Colby College - New Hampshire, 508 F.2d 804, 810 (1st Cir. 1975). We hold that Leathersmith of London has plainly not made that proof.

There is, first of all, no confusion as to the separate and unrelated character

of the businesses of the two parties. The District Court so held, and plaintiff does not claim otherwise. Plaintiff is a large, international concern, with wide marketing, while defendant is small, local to the Boston area, and deals only in his own custom work. The word "Leathersmith" does not appear on defendant's products, nor is it used in connection with those products except as it appears in defendant's name, "TANTALUS Custom Leathersmiths and Bookbinders." In that name, "Leathersmiths" is obviously employed to describe one of defendant's crafts--worker in leather--parallel to the other term in the name "Bookbinders". (The District Court so found, wholly correctly.) There is no likelihood that purchasers or shippers

would consider the two businesses connected in any way.

Nor is there likelihood of confusion or mistake as to the source or origin of Alleyn's goods.² As we have said, "Leathersmith" did not appear on, or in connection with, defendant's goods (except with respect to the name of the business); Alleyn's goods, while made of leather, were all custom-made for the particular customer who would know that they came from defendant, not plaintiff or some other source; plaintiff's leather goods, on the other hand, were prefabricated and sold at retail by a company called "Leathersmith of London". Alleyn's only use of "Leathersmith", in the name of his business, shows clearly that that word refers to the craft, not

to the source or origin of the products, and that business name ("TANTALUS Custom Leathersmiths and Bookbinders") is quite different from either "Leathersmith" alone or plaintiff's name, "Leathersmith of London." Moreover, there is no overlap between the marketing channels used by plaintiff and those of defendant.

Alleyn sells his own custom-made products through his shop and does not sell the products of any other person (including plaintiff and plaintiff's parent). This absence of convergent marketing channels or of competition serves to decrease the likelihood of confusion. Cf. AMF, Inc. v. Sleekcraft Boats, 599 F.2d 341, 353 (9th Cir. 1979); Fairway Foods v. Fairway Markets, 227 F.2d 193 (9th Cir. 1955); Griesdeck Western Brewing Co. v. Peoples

Brewing Co., 149 F.2d 1019, 1022-23
(8th Cir. 1945).

Plaintiff's only response is that, since its mark is valid and incontestable, defendant's use of the very words "Leathersmith" or "Leathersmiths" is enough to show likelihood of confusion or mistake. That might be true where the goods are identical and are marketed in the same channels of trade (see American Home Products v. Johnson Chemical Co., 589 F.2d 103, 106-07 (2d Cir. 1978)), but the rule is quite inappropriate here where the circumstances differ so markedly: the goods are not identical and there are no converging market channels; "Leathersmiths" is used only in defendant's business name and indisputably refers to Alleyn's craft, not to the goods; even

then, "Leathersmiths" appears only as one part of that business name which as a whole is unmistakably different from the trademark or from "Leathersmith of London."

In sum, the record permits no conclusion other than that there is no likelihood of confusion, mistake, or deception.

II

Alternatively, plaintiff falls afoul of the so-called "fair use" defense given by the Lanham Act. That statute provides (15 U.S.C. § 115(b) (4)) that, in the case of a registered mark that has become incontestable,³ registration "shall be conclusive evidence of the registrant's right to use the registered mark * * * except

when one of the following defenses or defects is established:

* * * *

(4) that the use of the name, terms, or device charged to be an infringement is a use, otherwise than as a trade or service mark, of the party's individual name in his own business, or of the individual name of anyone in privity with such party, or of a term or device which is descriptive of and used fairly and in good faith only to describe to users the goods or services of such party, or to their geographic origin; * * *." (Emphasis added).

This case fits within the emphasized words of this statutory defense. Alleyne did not adopt "Leathersmith" (or "Leathersmiths") as a trade or service mark, but rather, as the court below specifically found, "as a generic description of his craft." The finding as to intent is supported by defendant's

affidavit, not contravened by anything else, and is binding. "Leathersmith" can easily be such a description of the craft of working with leather; it is a combination of the ordinary words "leather" and "smith",⁴ comparable to "tunesmith", "jokesmith", "songsmith", and "wordsmith" (which appear in Webster's Third New International Dictionary of the English Language (1968)). Defendant's innocent good faith without any knowledge of plaintiff's trademark or business, was also found below, and is not now contested. Similarly, there is no evidence of any intent to deceive customers or to appropriate plaintiff's good will.

It follows that Alleyn has decisively proved that he has fairly and

in good faith used "Leathersmith", not as a trade or service mark, but only as descriptive, to describe to users the type of goods he provides. This usage is wholly within the terms and meaning of 15 U.S.C. § 1115(b)(4), supra. He has therefore a full defense for his employment of "Leathersmith". Cf. M.B.H. Enterprises, Inc. v. WOKY, Inc., 633 F.2d 50 (7th Cir. 1980); Abercrombie & Fitch Co. v. Hunting World, Inc., 537 F.2d 4, 12-13 (2d Cir. 1976).

For these reasons, the decision below is

Affirmed.

FOOTNOTES

1. We leave open the question whether "Leathersmith" is too generic to be registered. We note, too, that the District Court did not consider plaintiff's claim that this should be a class action; nor need we do so in the light of our holding.

2. There was obviously no deception since defendant innocently adopted his business name, without knowledge of plaintiff's trade name or trademark. In addition, it is relevant that plaintiff made no showing whatever of actual confusion. See AMP, Inc. v. Fay, 540 F.2d 1181, 1185-86 (4th Cir. 1976).

3. We assume, though there is some dispute on the point, that plaintiff's mark has become incontestable under 15 U.S.C. § 1065.

4. Webster's Third New International Dictionary defines "smith" as including "one who constructs, builds, or produces something; maker--often used in combination (skismith) (tune-smith)."

Plaintiff has claimed that the word was originally derived by plaintiff's English parent (T. J.&J. Smith, Ltd.) through a combination of its trade (leather) with that company's name (Smith), but the District Court cor-

rectly noted that courts must look, not to the owner's subjective intent, but to the natural interpretation the public would give to the word. "We are dealing here with the common use of language." Application of Automatic Radio Mfg. Co., 404 F.2d 1391, 1395 (CCPA 1969).

DECISION OF THE UNITED STATES
DISTRICT COURT, DISTRICT OF
MASSACHUSETTS

UNITED STATES DISTRICT COURT
DISTRICT OF MASSACHUSETTS

LEATHERSMITH OF LONDON, LTD.,)
a New York Corporation,)

Plaintiff,)

v.)

PHILIP J. S. ALLEYN, doing)
business as Tantalus Custom)
Leathersmiths & Bookbinders,)
as an individual defendant)
and as representative of a)
class,)

Defendant.)

CIVIL ACTION
NO. 79-2040-N

MEMORANDUM AND ORDER

NELSON, D. J. JANUARY 26, 1982

Plaintiff brought this trademark
action under the Lanham Act, 15 U.S.C.
§ 1051 et seq., and seeks to enjoin

defendant from infringing its registered trademark and engaging in unfair practices. Plaintiff also seeks like sanctions against all members of the class who, allegedly, similarly infringe plaintiff's rights.¹ Both parties have moved for summary judgment and have submitted extensive affidavits.

The essential facts are not in dispute, and I find as follows. Plaintiff, Leathersmith of London, Ltd., is a New York corporation, and a subsidiary of T. J. & J. Smith, Ltd. of London, England.² Plaintiff merchandises leather products throughout the United States, including Massachusetts. Plaintiff adopted the trademark "Leathersmith"

1. All footnotes are at end of Decision.

in 1949, and subsequently registered it with the United States Patent Office for use on its various leather products. Since 1975, defendant has conducted a business in Cambridge, Massachusetts under the name "TANTALUS Custom Leathersmiths and Bookbinders." Prior to that time, from 1971-1975, defendant conducted his business in Boston and out of his home as "TANTALUS Custom Leathersmiths." Defendant is a skilled leather craftsman and book-binder. He teaches his craft and sells his goods on a custom basis out of his only shop in Cambridge. He services an exclusive clientele who desire custom-made leather goods. Defendant does no significant advertising. He earns approximately \$8,000 per year from his

business. Until the commencement of this action, defendant was unaware of plaintiff's trademark or business.

Plaintiff does not, and could not reasonably, claim that the two names "Leathersmith of London" and "TANTALUS Custom Leathersmiths and Bookbinders" could lead the public to confuse the two businesses, and conclude that they are related.³ Rather, plaintiff claims that its mark "Leathersmith" is a registered trademark entitled to protection. Defendant responds that "leathersmith" is a generic term for leather craftsmen, and is not entitled to protection. After careful consideration of the applicable law, the Court denies plaintiff's request for a preliminary injunction and grants defendant's

motion for summary judgment.

The fact that plaintiff may have used the name "Leathersmith" prior to anyone else, and has spent considerable money and effort to promote the term in its name, cannot deprive competitors of using the term if it is generic. Competitors should be free to describe their goods (or professions) as what they are. Miller Brewing Co. v. Falstaff Brewing Co., 655 F.2d 5, 8 (1st Cir. 1981). See S. S. Kresge Co. v. United Factory Outlet, Inc., 634 F.2d 1, 2 (1st Cir. 1980) ("Mart" as commonly used for "market" or "store" is a generic term, and cannot be used as a valid trade name).

The issue to be decided, then, is whether "leathersmith" is a generic term,

or a term properly entitled to trademark protection. "Generic term" has been defined as follows: "A generic term is one that does not distinguish the goods of one producer from the goods of others. Instead, it is one that either by definition or through common usage 'has come to be understood as referring to the genus of which the particular product is a species.' No amount of purported proof that a generic term has acquired secondary meaning associated with a particular producer can transform that term into a registrable trademark." Keebler Co. v. Rovira Biscuit Corp., 624 F.2d 366, 374 (1st Cir. 1980); See Miller Brewing Co., supra.

In determining whether a trademark distinguishes the goods of one producer

from another, it is important to establish what the public understands the term to mean. See Kellog Co. v. National Biscuit Co., 305 U.S. 111, 118 (1939); McCarthy, Trademarks and Unfair Competitions, § 12:2 (1973). The Court is mindful that in resolving this issue it is dealing with the common use of language. Application of Automatic Radio Mfg. Co., 404 F.2d 1391, 1395 (C.C.P.A. 1969).

The term "leathersmith" is comprised of two common terms "leather" and "smith."⁴ The word "smith" was originally confined to describing craftsmen in the metals trades (e.g. "goldsmith" and "silversmith"). The use of the word has been expanded, however, and is now recognized as used in combination to define one who constructs or produces something

(e.g. "skismith" and "jokesmith"). See Webster's Third New International Dictionary of the English Language Unabridged (4th ed. 1976). A worker in leather has traditionally been called a leather worker or leather craftsman.⁵ Plaintiff has coined "leathersmith" to identify it as a dealer in leathergoods. However, as noted, "leathersmith" is a natural derivation of "leather worker" and "smith," and by dictionary definition, "leathersmith" means one who constructs or produces leather products. A new term is not protected where it naturally derives from established generic terms, and can be expected to be used as a generic term for the product. See Leon Finker, Inc. v. Schlussel, 496 F. Supp. 674, 678-79 (D. N.J. 1979),

aff'd. 614 F.2d 1288 (2d Cir. 1979).

(The Court held that the word "trillion" was adopted from the generic term "trilliant," for brilliant triangular diamonds, and was generic and unprotected).

Further, even a new term not derived from established generic terms may be generic ab initio if the term, by its nature, conveys a specific and correct meaning. See Cummins Engine Co. v. Continental Motors Corp., 359 F.2d 892, 894-95 (C.C.P.A. 1966) ("turbodiesel" coined to describe new diesel engine held to be generic). Defendant's use of the term in his corporate name "leathersmiths and bookbinders," clearly establishes his intent to use it as a generic description of his craft. He has also

submitted the affidavit of an expert public opinion pollster, who establishes that the vast majority of the public immediately recognize "leathersmith" as denoting a craftsman in leather. Plaintiff, on the other hand, has made no showing that the term "leathersmith" has any meaning in the mind of the consuming public other than a generic term for a leatherworker. See S. S. Kresge, 598 F.2d at 696.

The court finds that the term "leathersmith" is a generic term for a leather craftsman, and, therefore, that it cannot be a registrable trademark. Plaintiff's motion for a preliminary injunction is denied. Defendant's motion for summary judgment is allowed. Judg-

ment shall enter in favor of defendant.

S/ David S. Nelson
DAVID S. NELSON
UNITED STATES DISTRICT JUDGE

FOOTNOTES

1. The Court's determination in this matter necessarily disposes of the class action aspect of the complaint. It is, therefore, unnecessary to address whether the particular requirements for a class action under F. R. Civ. P. 23 were met in this case.

2. Defendant has not challenged plaintiff's right to bring this action, and, therefore, I assume that plaintiff is empowered to bring this action as an exclusive licensee. See Quabaug Rubber Co. v. Fabiano Shoe Co., Inc., 567 F.2d 154, 158 (1st Cir. 1977).

3. This is particularly so given the nature of the two businesses, the international marketing of Leathersmith of London and the purely local, custom work of TANTALUS.

4. Although plaintiff claims that "leathersmith" was originally derived by

combining its trade, "leather" and its name, T. J. & J. Smith, the Court looks to the natural interpretation the public will give the word, and not plaintiff's subjective intent. See Automatic Radio, 404 F.2d at 1395.

5. "Leathersmith", itself, does not appear in the dictionary. Although the occurrence of the word in the dictionary is useful in determining if it is generic, it is not decisive. See S. S. Kresge Co. v. United Factory Outlet, Inc., 598 F.2d 694, 696 (1st Cir. 1979) (useful), and Cumming Engine Co., 359 F.2d 892 (not a requirement).

CONSTITUTION OF THE UNITED STATES OF
AMERICA

Amendment V

No person shall be held to answer for a capital, or otherwise infamous crime, unless on a presentment or indictment of a Grand Jury, except in cases arising in the land or naval forces, or in the militia, when in actual service in time of war or public danger; nor shall any person be subject for the same offense to be twice put in jeopardy of life or limb; nor shall be compelled in any criminal case to be a witness against himself, nor be deprived of life, liberty, or property, without due process of law; nor shall private property be taken for public use without just compensation.

Amendment XIV

1. All persons born or naturalized in the United States and subject to the jurisdiction thereof, are citizens of the United States and of the State wherein they reside. No State shall make or enforce any law which shall abridge the privileges or immunities of citizens of the United States, nor shall any State deprive any person of life, liberty, or property, without due process of law; nor deny to any person within its jurisdiction the equal protection of the laws.

2.

Lanham Act of 1946

Section 7(b)
15 U.S.C. 1057(b)

Certificates of registration of marks registered upon the principal register shall be issued in the name of the United States of America, under the seal of the Patent Office, and shall be signed by the Commissioner or have his signature placed thereon, and a record thereof shall be kept in the Patent Office.

. . . .

Section 15
15 U.S.C. 1065

Except on a ground for which application to cancel may be filed . . . and except to the extent, if any, to which the use of a mark registered on the principal register infringes a valid right acquired under the law of any State or Territory . . . the right of the registrant to use such registered mark in commerce for the goods or services on or in connection with which such registered mark has been in continuous use for 5 consecutive years subsequent to the date of such registration and is still in use in commerce, shall be incontestable: . . .

Section 22
15 U.S.C. 1072

Registration of a mark
on the principal register provided
by this Act . . . shall be
constructive notice of the regis-
trant's claim of ownership thereof.

28 U.S.C. 1254

Cases in the courts of
appeals may be reviewed by the
Supreme Court by the following
methods:

(1) By writ of certiorari
granted upon the petition of any
party to any civil or criminal
case, before or after rendition
of judgment or decree;

. . .